

REMARKS

Applicants hereby traverse the current rejections, and request reconsideration and withdrawal in light of the remarks contained herein. Claim 38 is indicated as having allowable material. Claims 21-40 are pending in this application.

Doubling Patenting Rejection

Claims 21-23, 26, and 29-38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,651,193.

Applicants note the Examiner's rejection of claims 21-23, 26 and 29-38 under the judicially created doctrine of obviousness-type double patenting. Applicants propose filing a terminal disclaimer in compliance with 37 C.F.R. 1.321(b) if the Examiner's rejection still properly stands upon Notice of Allowability of the present case.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 23 stands rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Specifically, the words "said group" in claim 23, line 15 lacks antecedent basis.

In response, Applicants note that claim 22, from which claim 23 depends, defines "a group". Thus, Applicants believe that there is proper antecedent basis for "said group" of claim 23. As each element of indefiniteness cited by the Office Action has been addressed with a corresponding argument, Applicants respectfully request the rejection of claim 23 under 35 U.S.C. § 112, second paragraph be withdrawn.

Rejection under 35 U.S.C. § 102

Claims 21, 24-31, and 39 are rejected under 35 U.S.C. § 102(e) as being anticipated by Gillett Jr., et al. ('585, hereinafter Gillett).

It is well settled that to anticipate a claim, the reference must teach every element of the claim, see M.P.E.P. § 2131. Moreover, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with respect to a claim, "[t]he elements must be arranged as required by the claim," see M.P.E.P. § 2131, citing *In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Furthermore, in order for a prior art reference to be anticipatory under 35 U.S.C. § 102 with

respect to a claim, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim,” see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicants respectfully assert that the rejection does not satisfy these requirements.

Claim 21 defines a method for providing a distributed high performance coherent memory with error containment that includes reading an error indication included in a data packet, reflective of a current state of a unit. Gillett does not disclose at least this limitation. The Office Action states that Gillett discloses the STAE and SRAE bits which reads on the limitations of claim 21. Column 8, line 35 to column 9, line 2, Gillett teaches that the STAE bit is not part of a packet, but rather is part of a page control table (i.e. the transmit page control table). Similarly, the SRAE bits also are not part of a packet, but also are part of a page control table (i.e. the receive page control table), see Table 1. Thus, Gillett does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 21 is patentable over the 35 U.S.C. § 102 rejection of record.

Claim 39 defines a system for error containment comprising means for transporting error indications together with data which is in error. Gillett does not disclose at least this limitation. The Office Action states that Gillett discloses the STAE and SRAE bits which reads on the limitations of claim 19. Column 8, line 35 to column 9, line 2, Gillett teaches that the STAE bit is not part of a packet, but rather is part of a page control table (i.e. the transmit page control table). Similarly, the SRAE bits also are not part of a packet, but also are part of a page control table (i.e. the receive page control table). Thus, Gillett does not teach all of the claimed limitations. Therefore, the Applicants respectfully assert that for the above reasons claim 39 is patentable over the 35 U.S.C. § 102 rejection of record.

Claims 24-31 depend directly from base claim 21, and thus inherits all limitations of claim 1. Each of claims 24-31 sets forth features and limitations not recited by Gillett. Thus, the Applicants respectfully assert that for the above reasons claims 24-31 are patentable over the 35 U.S.C. § 102 rejection of record.

Rejection under 35 U.S.C. § 103

Claims 22-23, 32-37, and 40 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gillett in view of Hornung (‘931).

Applicants respectfully asserts that Hornung '931 is not a valid prior art reference. As amended by the American Inventor's Protection Act of 1999 (the Act), signed on November 29, 1999, section 103(c) now states:

(c) Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. (Emphasis added).

Section 4807 of the Act further provides that this new provision applies to any application filed on or after the date of enactment, November 29, 1999. The filing date of this application, while still benefiting from the priority of its parent application, is after the effective date of the new law. See 37 C.F.R. § 1.53(d)(2).

The Examiner will note that Hornung, and this application are assigned to the same entity, Hewlett Packard Development Company (HPDC). An agreement dated January 31, 2003 transferred both the Hornung Patent and this application to HPDC. Hornung was filed before, but did not issue until after the current application's filing date. Therefore, the disclosure of Hornung is available only as 35 U.S.C. § 102(e)-type prior art. In that regard, 35 U.S.C. § 103(c) now provides that Hornung "shall not preclude patentability" of the claimed invention.

To establish a prima facie case of obviousness, three basic criteria must be met. See M.P.E.P. § 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Without conceding the first or second criteria, Applicants assert that the rejection does not satisfy the third criteria.

Applicant notes that Hornung is not a prior art reference. Gillett is not relied upon as teaching all elements of the claimed invention. Therefore, the Applicants respectfully assert that for the above reasons claims 22-23, 32-37, and 40 are patentable over the 35 U.S.C. § 103(a) rejection of record.

Conclusion

The Examiner is thanked for the indication that claim 38 includes allowable subject matter

For all the reasons given above, the Applicants submit that the pending claims distinguish over the prior art of record under 35 U.S.C. §§ 102 and 103. Accordingly, the Applicants submit that this application is in condition for allowance.

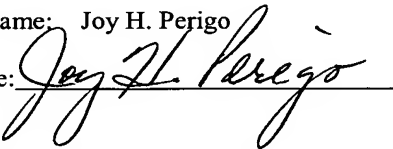
Applicants respectfully request that the Examiner call the below listed attorney if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 10002827-2 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Label No. EV482707920US in an envelope addressed to: M/S Amendment, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313.

Date of Deposit: 06-16-2005

Typed Name: Joy H. Perigo

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Respectfully submitted,

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